

**REMARKS**

Applicant respectfully requests reconsideration in view of the amendment and following remarks. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson et al. U.S. Patent 6,544,697 ("Thomson") in view of Ly et al. US2003/0064331 ("Ly") and European Patent Publication 1,089,125 ("EP '125"). Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Thomson, Ly and EP '125 as applied above and in further view of EP 490,416 ("EP '416"). Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication 270,078 ("EP '078") in view of Ly and EP '125. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,818,390 and claims 1-17 of U.S. Patent No. 6,821,719 optionally in view of Ly and EP '125. The applicant respectfully traverses these rejections.

The Examiner stated at page 2 of the office action that the term "deformable plastic support" is defined in the applicant's specification at page 5, lines 15-35. The applicant mostly agrees to the definition of the Examiner, but would like to replace the following part: "...that are not stretched and are elongated with heat ..." by "...that are not stretched and **can be** elongated with heat ...", as the "can" is also given in the definition on p. 5, line 26 of the present application.

**REJECTION OF CLAIMS 1-19**

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson in view of Ly and EP '125. Thomson discloses at col. 1, lines. 6-7, that "Conventional photographic material lacks stability when subjected to heat. Consequently, such material is unsuitable for use in moulding processes ...". This has also been experienced in the context of the present invention and is what a

person skilled in the art would expect knowing the limited stability of photographic materials. According to col. 1, lines 30-37 of Thomson, the material of the ('Thomson) invention is provided by coating a thermoplastic base with a primer layer and a light sensitive layer and after the processing with a protective thermoplastic foil. The description of the light sensitive layer can be found on col. 2, lines 30-31: "...the photographic emulsion layer 5, which may be of conventional type, e.g. Agfa Type 10". Even if "Agfa Type 10" would be interpreted as "Color negative paper Agfacolor Type 10" (to the applicant's knowledge, a film of this type as cited by the Examiner does not exist), a person skilled in the art would interpret this teaching to only mean one of the emulsion layers of the color paper and not the complete layer assembly that usually also comprises layers containing no emulsions. Therefore, the disclosure of Thomson does not support the "multi-layer light sensitive color photographic emulsion" as claimed for Thomson, that has neither been in the priority document nor in the PCT application as asserted by the Examiner at the bottom of page 2 to the top of page 3 of the office action.

As color photographic materials are much more complex than single layer photographic materials and therefore less stable, a person skilled in the art having read the aforementioned paragraph in col. 1, lines 6-7 of Thomson concerning the stability, would think of a single layer photographic material to be used for the Thomson invention.

According to the present invention it was surprisingly found, that a color photographic layer assembly as presently claimed can be used for a mouldable material, as long as the layer assembly is coated on a deformable plastic support as defined on see page 5, lines 15-35 of the present application. Further teachings how to select the plastics for the deformable plastic support are given on page 7, line 29 to page 10, line 4.

Although Thomson discloses e.g. in col. 1, lines 42-63 to use a thermoplastic base and also gives some examples thereof, there is no hint in Thomson to select the support to be a deformable plastic support as defined for the present invention.

According to the present invention it was found, that a color negative material comprising a deformable plastic support as defined for the present invention and coated thereon a layer assembly with silver chloride rich emulsions doped with iridium as presently claimed, has a significant better storage stability than a material containing emulsions with less iridium. This can be clearly seen in table 4 of Example 4, that also shows, that supports that contain no additives like plastizisers are preferred. The storage stability test (4 weeks at 37 °C, unexposed and unprocessed material) simulates the long term storage stability of the material between production and use and is completely different to the latent image stability that relates to the stability after exposure and before development.

Thomson does not suggest to use a color photographic material as presently claimed, but instead discloses, that conventional photographic materials lacks stability when subjected to heat, a person skilled in the art would not have combined the teaching of Thomson with the teaching concerning a conventional photographic material. Therefore a person skilled in the art would not have combined the teaching of Ly with the teaching of Thomson. This holds furthermore, as Ly gives no hint, how to increase the storage stability and in particular, is silent with respect to an influence of the plastic substrate.

Although EP '125 is directed to a coated flexible polymer sheet that can be used in packaging, it is nevertheless a conventional material with respect to the meaning in the Thomson, as EP '125 material is not meant to be deformed at high temperatures, but is coated and processed in the conventional way. Additionally EP '125 teaches at page 7 in [0046], lines 13-14, at page 9, in [0063] and in [0064], that the support is a biaxially oriented (biaxially stretched) sheet, that is not a deformable support and therefore can not be used for the present invention. In addition EP '125 gives

no hint, how to increase the storage stability (unexposed) and in particular is silent with respect to an influence of the plastic substrate. Therefore a person skilled in the art would not have combined the teaching of Thomson with the teaching of EP '125.

As a person skilled in the art would neither have combined Thomson with Ly nor with EP '125 and as none of the three references teaches a deformable plastic support as presently defined, the present invention is not rendered obvious by said references and the rejection of claims 1-19 should be withdrawn.

#### **REJECTION OF CLAIM 5**

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Thomson, Ly and EP '125. As claim 5 is not rendered obvious by Thomson, Ly and EP '125, the same holds for the further combination with EP '416, as EP '416 does neither disclose nor suggest the photographic layers of the present invention. A person skilled in the art searching for an adhesive layer between a deformable plastic support and a color photographic silver halide layer assembly would not have taken EP '416 into regard, as the teaching of EP '416 is related to a black and white DTR layer, that is completely different to the color layer assembly of the present invention and is also different to the photographic emulsion layer known from Thomson.

Furthermore a person skilled in the art would know that the deformation at high temperature, that the material of the present invention has to withstand, will be critical for the selection of the adhesive layer and would not take EP '416 into regard, as it is silent with respect to said deformation. For the above reasons, the rejection of claim 5 should be withdrawn.

#### **REJECTION OF CLAIMS 1-13**

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '078 in view of Ly and EP '125. As discussed in the section above relating to the rejection of claims 1-

19 Ly and EP '125 give no hint, how to increase the storage stability and in particular are silent with respect to an influence of the plastic substrate. Therefore a person skilled in the art would not combine the teaching of EP '078 with Ly and/or EP '125 to come to the present invention.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish

prima facie case of obviousness (*In re Geiger*, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine EP '078 with Ly and/or EP '125.

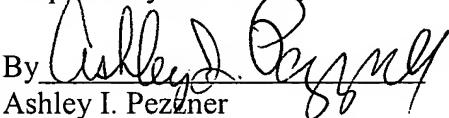
**DOUBLE PATENTING REJECTIONS**

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,818,390 and claims 1-17 of U.S. Patent No. 6,821,719 optionally in view of Ly and EP '125. The applicant respectfully disagrees. However, the applicant will file a terminal disclaimer when the other rejections are withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12980-00006-US from which the undersigned is authorized to draw.

Respectfully submitted,

By   
Ashley I. Pezzner

Registration No.: 35,646  
CONNOLLY BOVE LODGE & HUTZ LLP  
1007 North Orange Street  
P.O. Box 2207  
Wilmington, Delaware 19899  
(302) 658-9141  
(302) 658-5614 (Fax)  
Attorney for Applicant